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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/709,181	04/20/2004	Rainer Schimpf		3180

7590
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10/09/2007

EXAMINER

AUGUSTIN, EVENS J

ART UNIT	PAPER NUMBER
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3621

MAIL DATE	DELIVERY MODE
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10/09/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/709,181

Applicant(s)

SCHIMPF, RAINER

Examiner

Evans Augustin

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☒ Claim(s) 1 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-10 are pending and have been examined.

Claim Interpretation

2. In determining patentability of an invention over the prior art, the USPTO has considered all claimed limitations, and interpreted as broadly as their terms reasonably allow. Additionally, all words in the claims have been considered in judging the patentability of the claims against the prior art.
3. It should also be noted that, in the office action that:
 - A. Items in the rejection that are in quotation marks are claimed language/limitations.
 - B. Passages in prior art references may be mere rephrasing/rewording of claimed limitations, but the implicit/explicit meaning of the references vis-à-vis the claimed limitation remains intact.
 - C. Functional recitation(s) using the word “for” or other functional terms have been considered but given less patentable weight¹ because they fail to add any steps and are thereby regarded as intended use language. To be especially clear, the Examiner has considered all claim limitations. However the A recitation of the intended use of the claimed invention must result in additional steps. See *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1375-76, 58 USPQ2d 1508, 1513 (Fed.

¹ See e.g. *In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983)(stating that although all limitations must be considered, not all limitations are entitled to patentable weight).

Cir. 2001) (Where the language in a method claim states only a purpose and intended result, the expression does not result in a manipulative difference in the steps of the claim.).

- D. Limitations that recite the purpose of a process or the intended use of a structure are generally not given any patentable weight. Patentable weight is therefore given to the actual process steps or structural limitations.
- E. Word(s) that are separated by “/” are being examined as being synonymous or equivalent.
- F. “Sequence” is being interpreted as a barcode or alphanumeric code or data embedded in an RFID tag.
- G. The USPTO interprets claim limitations that contain statement(s) such as “*if, may, might, can, could, when, potentially, possibly*”, as optional language (this list of examples is not intended to be exhaustive). As matter of linguistic precision, optional claim elements do not narrow claim limitations, since they can always be omitted (*In re Johnston*, 77 USPQ2d 1788 (Fed. Circ. 2006)). They will be given less patentable weight, because language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.
- H. Independent claims are examined together, since they are not patentable distinct. If applicant expressly states on the record that two or more independent and distinct inventions are claimed in a single application, the Examiner may require the applicant to elect an invention to which the claims will be restricted.

- I. Any official notices taken by the USPTO that are not adequately traversed by applicant will be taken to be admitted prior art.
- J. The USPTO interprets common computer related words that are not lexicographically defined, in accordance to Computer Dictionary, 3rd Edition, Microsoft Press, Redmond, WA, 1997². The USPTO also uses published patent applications and issued patents as well, for meanings of common computer related words that are not lexicographically defined. Accordingly, a barcode is defined as: a special identification code printed as a set of vertical bars of differing widths on books, grocery products, and other merchandise. Used for rapid, error-free input in such facilities as libraries, hospitals, and grocery stores, bar codes represent binary information that can be read by an optical scanner. The coding can include numbers, letters, or a combination of the two; some codes include built-in error checking and can be read in either direction.

Claim Objections

4. Claim 1 is objected to as being in improper form. The preamble of the claim is regarding a process, which either has to be a process or an apparatus, but not both. Some limitations

² Based upon Applicants' disclosure, the art of record, and the knowledge of one of ordinary skill in this art as determined by the factors discussed in MPEP §2141.03 (where practical), the Examiner finds that the *Microsoft Press Computer Dictionary* is an appropriate technical dictionary known to be used by one of ordinary skill in this art. See e.g. *Altiris Inc. v. Symantec Corp.*, 318 F.3d 1363, 1373, 65 USPQ2d 1865, 1872 (Fed. Cir. 2003) where the Federal Circuit used the *Microsoft Press Computer Dictionary* (3d ed.) as "a technical dictionary" to define the term "flag." See also *In re Barr*, 444 F.2d 588, 170 USPQ 330 (CCPA 1971)(noting that its appropriate to use technical dictionaries in order to ascertain the meaning of a term of art) and MPEP §2173.05(a) titled 'New Terminology.'

such as "encoding a sequence by using a computer system " are process claim. Other limitations such as "verify said sequence with data stored on a said computer system to determine a product as original or as falsification " are not proper method/process limitations. Applicant should make to correction to reflect the step of "verifying...".

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requires of this title.

6. According to the MPEP 2173.05 (p) a claim which claims both an apparatus and the method steps of using the apparatus is rejected under 35 U.S.C. 101 based on the theory that the claim is directed to neither a "process" nor a "machine," but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only. *Id.* at 1551.
7. Accordingly, claim 6 is rejected under 35 U.S.C. 101 because the claim is directed to neither a "process" nor a "machine," but rather embraces or overlaps two different statutory classes of invention. The preamble of the claim is regarding a method of protecting products against counterfeiting by delivering an encoded sequence. Therefore, the claim embraces or overlaps two different statutory classes of invention.
8. Claims 1-10 are rejected 35 U.S.C. 101. The claims seem to be method claims, but they do not recite method steps. Since the claims do not recite method steps, they are directed to

neither one of the four categories of inventions that Congress deemed to be the appropriate subject matter of a patent (processes, machines, manufactures and compositions of matter).

Claim Rejections - 35 USC § 112 – 2nd Paragraph

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. According to MPEP 2173.05 (q), attempts to claim a process without setting forth any steps involved in the process generally raises an issue of indefiniteness under 35 U.S.C. 112.

Accordingly, claim 2 is directed to "A computer system of claim 1 to: a) encode sequences and; b) decode sequences and; c) carry out tests of the consistency of encoded sequences and; d) carry out comparison of said sequences with stored data on said computer system and; e) store data on said computer system and; f) legitimize parties to access the said computer system and; g) legitimize parties to process data on the said computer system and; h) generate and send messages". The claim does not include the steps or process involved in accomplishing the limitations in the claim. The claim is therefore indefinite under 35 U.S.C. 112. Claims 4, 5 and 8-10 are also rejected in the same manner.

11. Claims 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. For example, it is not clear whether the claim is regarding "a symmetric encryption method; b) a symmetric decryption method; c) an asymmetric encryption method; d) an asymmetric decryption method; e) a symmetric encryption method and a hash method; f) a symmetric decryption method and a hash method; g) an asymmetric encryption method

and a hash method; h) an asymmetric decryption method and a hash method” in the alternative or whether the invention encompasses all of methods. Additionally, the claim seems to be regarding a method comprising of number of methods. Limitations for a method claim should involve the actual detailed steps for accomplishing the method. Therefore, all of the other claims in this applications are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claims 1-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Silverbrook et al. (U.S 20040195342).

14. As per claims 1-10, Silverbrook et al. discloses an invention comprising of the following:

- A. A coded barcode which encodes an a product identifier (par. 248-249, 348) or coded data an RFID tag which identifies the product (par. 258-259)—(**“encoding a sequence by using a computer system”**);
- B. The barcode allows individual product items to be uniquely identified and thereby tracked (par. 8)- RFID tags constitute a sufficiently unique signature for tracking purposes (par. 1331) —(**“method to assure that only unique sequences are calculated”**);
- C. Prior art teaches the aspect of having both barcode and RFID tagged items/products –
- delivering the product is inherent - (par.1134)(**“delivering the said sequence with a product;**
- D. Transferring the indicating data to a computer system, the computer system being responsive to the indicating data to update product status information stored in a data store (par. 71) -- (**“transmit said sequence to a computer system”**);
- E. Reading or verifying product to determine whether product as been stolen (par. 1300)
– The unique item IDs make semi-automatic scanning possible, and semi-automatic scanning of unique IDs result in more accurate scanning and prevents fraudulent collusion between the operator and the customer (par. 1127) —(**“verify said sequence by using a computer system to identify the consistency of said sequence;”**)
(**“verify said sequence with data stored on a said computer system to determine a product as original or as falsification”**)

- F. The tag contains information which indicates/reports that the item has not been legitimately obtained (same as verification) (par. 1300) --(**“report the result of verification.”**)
- G. Encoding the product identity data in an RFID tag (par. 357) (**“encode sequences”**)
- H. Tag decoding (par. 530, 1150) --(**“decode sequences”**)
- I. The checking of the legitimacy of items by auditing/testing the tags for fraudulent activities (par 1300, 1315, 1323)– inherently the system if a tag has tempered with or not consistent with the original tag placed on the item or could not read a particular tag (**“carry out tests of the consistency of encoded sequences”**)
- J. Comparing the item ID (par. 1269-1270) (**“carry out comparison of said sequences with stored data on said computer system”**)
- K. Tag information stored in a data store (par. 71, 75-76, 80, 85) -- (**“store data on said computer system”**) and;
- L. Authenticating/legitimizing parties (par. 785, 789) --(**“legitimize parties to...”**)
- M. Using symmetric and asymmetric cryptography (par. 786-787), along with a hash (par. 88)--(**“utilizing: a) a symmetric encryption method or; b) an asymmetric encryption method or; c) by utilizing in addition a hash method to a symmetric encryption method or; d) by utilizing in addition a hash method to an asymmetric encryption method”**).
- N. With item-level tagging, inventory records intrinsically become more accurate, with the consequence that automatic reordering and replenishment becomes more reliable and hence relied-upon (par. 1302) --(**“ using encoded sequences and deliver the**

same number of encoded sequences to a manufacturer as number of products are ordered by a customer”)

Conclusion

15. *Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that if the applicant is preparing to respond, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.*
16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Evens Augustin whose telephone number is 571-272-6860. The examiner can normally be reached on Monday thru Friday 8 to 5 pm.
17. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on 571-272-6779.

/Evens J. Augustin/
Evens J. Augustin
October 1, 2007
Art Unit 3621